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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,555	02/20/2002	Ronald M. Evans	SALK2270-5 (088802-5212)	6168
30542	7590	08/09/2005	EXAMINER	
FOLEY & LARDNER P.O. BOX 80278 SAN DIEGO, CA 92138-0278			KATCHEVES, KONSTANTINA T	
			ART UNIT	PAPER NUMBER
			1636	
DATE MAILED: 08/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,555

Applicant(s)

EVANS ET AL.

Examiner

Konstantina Katcheves

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 27-29 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 5, 27-29, 35 and 38-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 32, 33, 34, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 2-5, 27-29, 32-40 are pending in the present application. Claims 2, 3, 5, 27-29, 35, 38, 39 and 40 are withdrawn from consideration pursuant to a previous restriction requirement. Claims 4, 32, 33, 34, 36 and 37 are currently under examination.

Election/Restrictions

Applicant's election with traverse of CYP3A promoter, SEQ ID NO:3 response element and luciferase as the reporter in the reply filed on 03 June 2005 is acknowledged. The traversal is on the ground(s) that the specific promoters, response element and reporters are "relatively unimportant" to the method. This is not found persuasive because the relative importance of limitations to the claimed invention is not the standard for an election of species. Rather, the election of species depends on whether the claims comprise a multiplicity of species and whether such a multiplicity of species would result in a burdensome search. As such the generic classes of promoters, response elements and reporters are so generic such that a search of all species that fall within such a class would be unduly burdensome and require an election of species for search purposes. See MPEP 808.01.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4, 33, 34 and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of copending Application No. 10/302557. Although the conflicting claims are not identical, they are not patentably distinct from each other because both methods share the same method steps and element. The method of the instant claims comprises contacting a host cell comprising a SXR protein with a reporter vector comprising a promoter, a SXR response element, and reporter protein. The method of the copending '557 application is drawn to a method comprising culturing cells transformed with a vector for the expression of an indicator protein, *i.e.* reporter. The vector comprising a DNA response element operatively linked to a promoter and wherein the response element comprises the same half sites separated by three, four or five spacer nucleotides found in claims 33, 34 and 36 of the present application. Therefore the invention of

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the instant claims would have been obvious to one of ordinary skill in the art at the time the invention was made. Although the claims of the copending application do not specifically recite that the host cell comprises an SXR polypeptide, the vector of the copending application comprises a response element that is specific to such a polypeptide. Consequently, the cell of that method would inherently possess an SXR polypeptide. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 4 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The written description requirement is established by 35 U.S.C. 112, first paragraph which states that the: “*specification* shall contain a written description of the invention . . . [emphasis added].” A specification must convey to one of skill in the art that “as of the filing date sought, [the inventor] was in possession of the invention.” See *Vas Cath v. Mahurkar* 935

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F.2d 1555, 1560 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Applicant may show that he is in “possession” of the invention claimed by describing the invention with all of its claimed limitations “by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” See *Lockwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

Claim 4, step (b) recites a response element said element functioning to activate the promoter of step (a). This is a genus claim that encompasses a broad genus of response elements. Applicant has failed to describe the full scope of this genus either with a disclosure of a representative number of species or relevant structure-function information. The specification does not disclose each response element embraced by the breadth of the claims. At best, the specification discloses representative species from a subgenus of response elements; *i.e.* SXR response element. Thus, the specification does not describe the complete structure of a representative number of species of the broad genus of response elements. Absent such teachings and guidance as to the structure-function relationship of these molecules, the specification does not describe the claimed genus of response elements in such full, clear, concise and exact terms so as to indicate that Applicant had possession of these molecules at the time of filing of the present application.

Claims 4, 32, 33, 34, 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 4 recites the limitation "said SXR response element" in line 10. There is insufficient antecedent basis for this limitation in the claim. Claims 33, 34 and 37 are rejected as being dependent on a rejected base claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konstantina Katcheves whose telephone number is (571) 272-0768. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday 7:30 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Konstantina Katcheves
Examiner
Art Unit 1636



JAMES KETTER
PRIMARY EXAMINER